

REMARKS

The above amendments and these remarks are responsive to the Office action mailed September 1, 2005. This response is accompanied by a petition and fee to extend the period for response by one month from December 1, 2005 to January 1, 2006.

Currently, claims 1-55 are pending. The Office action indicates that:

(a) claims 1-15, 20, 24, 25, 47, and 53 stand rejected as being anticipated by Suryanarayana et al. (U.S. Patent No. 6,487,401);

(b) claims 16-19, 21-23, 26-39, 41-44 and 48-51 stand rejected as being unpatentable over Suryanarayana in view of Dahm, et al (U.S. Patent No. 6,466,783);

(c) claims 45, 46 and 55 stand rejected as being unpatentable over Smith et al. (U.S. Patent No. 6,084,951) in view of Henderson et al. (U.S. Patent No. 6,327,363), and claims 24 and 53 also stand rejected over this combination;

(d) claims 40 and 52 stand rejected as being unpatentable over Suryanarayana in view of Henderson; and claim 55 also stands rejected over this combination;

(e) claim 54 stands rejected as being unpatentable over Raith (U.S. Patent No. 6,493,547) in view of Suryanarayana.

In view of the remarks below, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111, withdrawal of the rejections, and allowance of the pending claims.

Amendments to the Specification

The specification has been amended in several places for correction of typographical errors and for completeness of disclosure.

More specifically, the paragraphs beginning on page 15, line 8, and on page 19, line 12,

respectively, have been amended to correct typographical errors. No new matter is entered by way of these amendments, which reconcile the detailed description with the drawings.

Also, two new paragraphs have been added, beginning on page 18, line 10. The two new paragraphs detail exemplary steps of a fraud detection method that may be applied in association with a payment account that a user may desire to use to pay for a recharge option. Support for these new paragraphs can be found in the application as filed and in U.S. Patent No. 6,516,056 to Justice, which issued from U.S. Patent App. Ser. No. 09/479,768, the disclosure of which is specifically incorporated by reference in the application as filed. More specifically, support for these new paragraphs can be found in Justice 4:34-40; 8:53-54; 8:65-9:9; 9:24-26; 9:41-59; 9:65-10:7; 11:1-13; 13:1-3; 13:11-12; 13:49-50; 17:55-19:10; and Figs. 3-9. As such, no new matter is entered by way of these amendments.

Finally, the paragraph beginning on page 18, line 10, which follows the two new paragraphs discussed above, has been amended for consistency and clarity with respect to the new paragraphs. No new matter is entered by way of these amendments.

Rejections under 35 USC § 102

Claims 1-15, 20, 24, 25, 47, and 53 stand rejected as being anticipated by Suryanarayana. Applicants note that the Suryanarayana patent was filed on December 18, 2000. Pursuant to 37 C.F.R. § 1.131, applicants submit herewith a declaration demonstrating invention of the claimed subject matter in this country prior to the filing date of the Suryanarayana patent. Particularly, applicants declare that conception of their invention occurred prior to December 18, 2000. Such prior conception is demonstrated, in part, by the story boards and other documents referenced in the declaration, which were created earlier than that date. Applicants also declare that they acted

diligently to reduce the invention to practice from a time prior to October 26, 2000 to the filing date of this application. Such diligence is demonstrated, in part, by their filing of a provisional application covering the invention on December 29, 2000. In view of applicants' prior invention of the subject matter of the pending claims, the rejections of the aforementioned claims under 35 U.S.C. § 102(e) should be withdrawn.

However, even ignoring applicants' prior invention of the subject matter recited in the claims rejected under 35 U.S.C. § 102(e), applicants submit that the rejection is improper. To anticipate a claim under 35 U.S.C. § 102, every element of the claim must be disclosed in a single prior art reference. However, the rejected claims include limitations not disclosed in Suryanarayana.

For example, independent claim 1 recites a wireless telephone device comprising, in part, a *"recharge option ... configured to cause the communications program to initiate both a connection to the communications network and a recharge transaction."*

However, Suryanarayana fails to disclose at least this limitation. More particularly, the Suryanarayana reference fails to disclose a recharge option that is configured to initiate either (1) a connection to the communication network or (2) a recharge transaction.

Remarks noting this distinction were presented in applicants' previous response filed June 24, 2005, but the tenor of the rejections in the present Office action indicates that applicants may have failed to clarify the distinction sufficiently. Applicants believe the following remarks more clearly set forth the failure of the Suryanarayana reference to properly anticipate the rejected claims, and thank the Examiner for considering them.

First addressing the nature of the connection to the communications network disclosed by the Suryanarayana reference, the prepaid wireless telephone account regeneration system clearly

indicates that all connections to a communications network regarding a prepaid calling account are initiated by a *recharge server*, and never by the *wireless device*.

For example, Fig. 3 of Suryanarayana illustrates a call flow diagram of the prepaid wireless telephone account regeneration system:

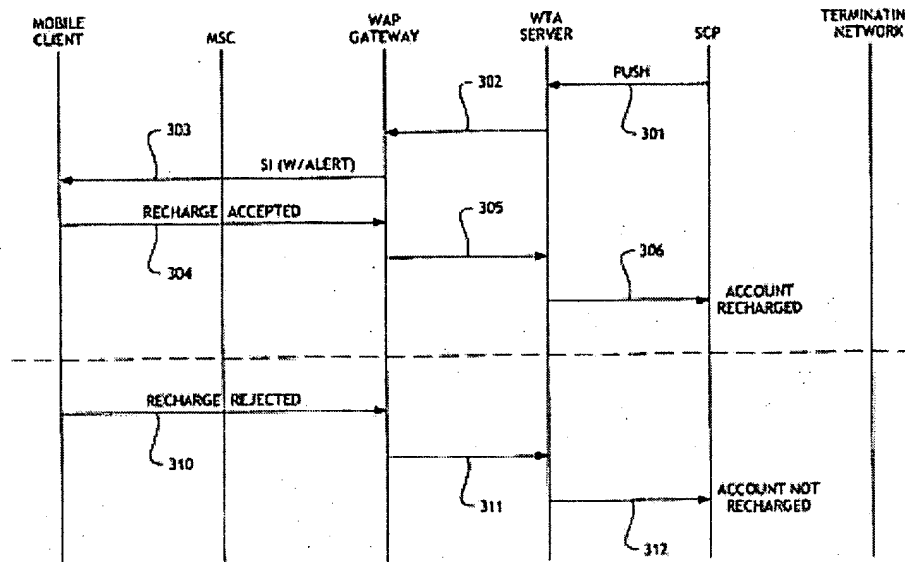


Fig. 3

Suryanarayana explains that “The process starts by the service control point (SCP) performing a push operation (301) to inform the cellular telephone user that a recharge of the prepaid account may be required” (4:6-8). The push signal containing the recharge information is then sent to a WTA server, forwarded to the WAP gateway, and then sent over the air to the WTA client in the mobile terminal (4:27-31).

Also, referring to a diagram illustrated in Fig. 4, Suryanarayana explains that the SCP may monitor a call in progress and send out a warning signal to the user’s mobile client if an account reaches a predetermined level during the call (5:8-11). Similarly, referring to Fig. 5, the reference explains that “The process starts by the SCP sending a message to the mobile client

software via the WAP network” (5:45-48). Referring to Fig. 8, the reference explains that the SCP authorizes a call placed by the mobile client, and notifies the mobile client of the anticipated cost of the call; the user may then continue or terminate the call (8:9-17).

Thus, in the Suryanarayana reference, communications relating to recharge and account information are *always* initiated by the SCP. **In other words, the mobile terminal (or wireless device) of the Suryanarayana reference never itself *initiates* or *establishes* such a connection to a communications network**, and it is not disclosed to be configured to do so. As such, Suryanarayana fails to disclose or suggest a wireless telephone device that includes a recharge option configured to initiate or establish a connection to a communications network. For at least this reason, Suryanarayana fails to anticipate the aforementioned claims.

Next addressing the nature of the recharge transaction disclosed by the Suryanarayana reference, a careful reading of the reference indicates that a recharge transaction is also always initiated by the SCP, and never by the wireless device.

As noted above, Suryanarayana teaches that the SCP informs the cellular telephone user that a recharge of the prepaid account may be required. The push signal containing the recharge information is sent from the SCP to the WTA client in the mobile terminal. At this point, the user decides whether or not to respond to the recharge notification, for example by accepting or rejecting the notification (4:37-41). “If the user accepts the recharge notification, the mobile client sends a ‘recharge accepted’ signal (304) to [the WTA server, which then] forwards the acceptance signal to the SCP” (4:42-46), at which point the SCP recharges the prepaid account (4:47).

It is important to note that a user signal that accepts or declines a recharge transaction, or otherwise responds to the recharge notification, is only *responsive* to a recharge transaction that

is initiated by a source external the mobile terminal: the SCP. **In other words, the mobile terminal (or wireless device) of the Suryanarayana reference may *complete* a recharge transaction, but never *initiates* one: the recharge transaction is *always* initiated by the SCP.** As such, Suryanarayana fails to disclose or suggest a wireless telephone device that includes a recharge option configured to initiate a recharge transaction. For at least this reason, Suryanarayana fails to anticipate the aforementioned claims.

Thus, because the mobile devices disclosed by Suryanarayana do not have a recharge option configured to cause the communications program to initiate either (1) a connection to a communication network or (2) a recharge transaction with the recharge service via the communication network, Suryanarayana cannot anticipate independent claim 1, or claims 2-15 and 20, which depend therefrom.

Similarly, independent claim 24 recites a method of recharging a stored-value calling account, comprising, in part, a *“in response to the received user selection of the recharge option, both establishing a connection to a communication network and initiating the recharge transaction.”* Independent claim 47 recites a pre-paid wireless telephone recharge system that includes a wireless telephone device having a *“recharge option ... configured to cause a communication program on the wireless telephone device to initiate both a connection to the communication network and a recharge transaction.”* Independent claim 53 recites a wireless telephone device that includes, in part, a *“recharge option ... configured to initiate both connection to a communication network and a recharge transaction.”* Thus, although each of the aforementioned claims recites different subject matter, they all share the common limitation of a wireless telephone device that includes a recharge option configured to initiate both (1) a connection to the communication network and (2) a recharge transaction. As shown above, since the mobile

devices disclosed by Suryanarayana do not have a recharge option configured to cause the communications program to initiate either (1) a connection to a communication network or (2) a recharge transaction with the recharge service via the communication network, Suryanarayana cannot anticipate independent claims 24, 47, or 53. Furthermore, because claim 25 depends from independent claim 24, this claim is allowable for at least the same reasons.

Accordingly, rejection of dependent claims 2-15, 20, and 25 also should be withdrawn for at least this reason.

Rejections under 35 USC § 103

Claims 16-19, 21-23, 26-39, 41-44 and 48-51 were rejected as being unpatentable over Suryanarayana in view of Dahm. These rejected claims all depend, either directly or indirectly, from independent claims 1, 24, or 47, which stand rejected under 35 U.S.C. § 102(b) over Suryanarayana. However, as discussed above, these rejections either are improper because Suryanarayana fails to disclose all of the limitations of these independent claims, or are obviated in light of applicants' declaration demonstrating completion of their invention in this country prior to the filing date of the Suryanarayana patent.

Also, as was demonstrated in applicants' previous response filed on June 24, 2005, Dahm similarly fails to disclose at least a wireless telephone device that includes a recharge option configured to initiate both a connection to the communication network and a recharge transaction. As such, no combination of Dahm with Suryanarayana can suffice to render obvious either the independent claims, or the claims that depend therefrom. Accordingly, applicants respectfully traverse the rejection of these claims and request that the rejection be withdrawn.

Claims 24, 45, 46, 53, and 55 were rejected as being unpatentable over Smith in view

of Henderson. Applicants respectfully traverse the rejection of these claims, for at least the reason that the proposed combination fails to teach at least some of the limitations of the rejected claims. For example, neither Smith nor Henderson discloses a wireless telephone device with an associated stored-value calling account, as required by each of the rejected claims. Further, neither Smith nor Henderson discloses a recharge option configured to initiate a recharge transaction in order to add calling units to the stored-value calling account, as required by each of the rejected claims.

In addition, applicant suggests that both references are nonanalogous art to this application, and that any combination of the references is impermissibly based on hindsight reconstruction. The disclosure of Smith is limited to graphical user interfaces in telephone devices, and is entirely unconcerned with wireless services, such as calling accounts associated with the telephone devices, much less whether such a calling account is post-paid or stored-value in nature. Smith also fails to make any mention of using a customized contact entry in a telephone device as a “recharge option” as the term is used in the applicants’ disclosure.

As such, the Smith reference is nonanalogous art inasmuch as it is neither within the field of applicants’ endeavor, being unconcerned with stored-value calling accounts, nor is it reasonably pertinent to the subject matter for which protection is being sought: for example, Smith is directed to the problem of storage of information in a telephone device (2:46-55).

Similarly, the disclosure of Henderson is limited to applications that provide customer service by using a network-based database to collect customer, product, and vendor data and to route incoming calls from customers to an appropriate service center. Much of the Henderson disclosure is concerned with handling a customer phone call after a customer service network receives such a phone call, in terms of routing or otherwise directing the phone call to a particular

destination within the customer service network. Even when referring to pre-paid customer service accounts associated with service cards, Henderson explains that although “a user can dial a predetermined access number to access the service card network,” the network routes the call via a bridging switch to a service control point, which then further routes the call to a voice port on an IP network, before finally triggering a software application for pre-paid card services (Figs. 3, 4; 8:35-44). In other words, the communications network of the Henderson reference that routes a phone call from a customer who, in this case, wants to recharge the balance in a pre-paid account, is entirely independent of and external to the calling device used by the customer to place the call.

The Henderson reference also is nonanalogous art as it is neither within the field of applicants’ endeavor nor reasonably pertinent to the subject matter for which protection is being sought. Henderson instead is concerned with routing a customer phone call through a service network that exists independent of and external to a phone used by the customer to place the call. For example, Henderson suggests providing a customer with a service card that bears information regarding the customer’s account, a practice explained in the application to be provided because it is “difficult for the user to remember the access number of the customer service representative, and the telephone card containing the access number may become lost or difficult to locate [and thus,] alternative approaches for recharging a stored-value calling account are desirable” (page 2, lines 17-21).

Thus, since neither reference alone discloses at least the aforementioned elements of a wireless telephone device with an associated stored-value calling account, or a recharge option configured to initiate a recharge transaction in order to add calling units to the stored-value calling account, no combination of the references suffice to support the rejection of the claims under 35 U.S.C. § 103(a). Moreover, since the disclosures of the Smith and Henderson references are related

only when the aforementioned limitations are assumed to be disclosed therein, the combination is based on hindsight reconstruction. Thus, for at least the reasons discussed above, applicants respectfully request withdrawal of the rejection of claims 24, 45, 46, 53, and 55.

Moreover, with respect to claim 55, the Office action asserts that Henderson teaches that “during a recharging procession, authentication can be performed.” However, regardless of whether this is an accurate characterization of the disclosure of Henderson, such authentication is not described to serve as application of fraud detection measures, insofar as the term is recited in claim 55 and used in the specification. Instead, Henderson describes that a customer is prompted for a credit card and that authorization of the charge is attempted (17:24-26). If authentication fails, the customer may attempt to try a new credit card number, or terminate the transaction (17:26-29). Applicants note that this procedure details none of the exemplary fraud detection steps disclosed in the specification, and is simply limited to a rudimentary authorization check prior to processing the charge. No fraud indicators are identified, no risk level is assessed, no procedures are described to determine actions based on comparison of the risk level with a predetermined threshold; in short, the Henderson authentication procedure fails to disclose the fraud detection measures recited in claim 55 in light of the specification. For at least this additional reason discussed above, applicants respectfully submit that the rejection of claim 55 should be withdrawn.

Claims 40, 52, and 55 were rejected as being unpatentable over Suryanarayana in view of Henderson. As demonstrated above, Suryanarayana is not valid prior art because of applicants’ prior invention of the subject matter recited in the claims rejected under 35 U.S.C. § 102(e) over the reference. Also, as shown in the above remarks, neither the Suryanarayana nor the Henderson references disclose at least the limitation of a “*recharge option in a wireless*

telephone device ... being configured to initiate a recharge transaction, in order to add calling units to a stored-value calling account associated with the wireless telephone device” as recited in claim 55 and claims 24 and 27, from which claims 40 and 52 depend, respectively. Accordingly, applicants traverse the rejection of claim 40, 52, and 55 over this combination and respectfully request that the rejection be withdrawn for at least this reason.

Moreover, with respect to claim 55, as mentioned above, the Office action concedes that “Suryanarayana fails to teach ... fraud detection measures.” As demonstrated above, Henderson similarly fails to teach or suggest fraud detection measures. As such, applicants respectfully note that no combination of the cited references suffice to disclose at least this element of claim 55. Thus, for at least this additional reason, applicants submit that the rejection of claim 55 should be withdrawn.

Claim 54 was rejected as being unpatentable over Raith in view of Suryanarayana. As demonstrated above, Suryanarayana is not valid prior art because of applicants’ prior invention of the subject matter recited in the claims rejected under 35 U.S.C. § 102(e) over the reference. As such, because the Office action explains that Raith “fails to teach” both “*detecting that the balance is lower than a predetermined threshold*” and “*presenting a recharge option to a display of the device*” as recited in claim 54, the Raith reference alone does not suffice to support the rejection of claim 54.

However, even ignoring applicants’ prior invention of the subject matter recited in the claims rejected over the Suryanarayana reference, applicants submit that the rejection is improper, because the disclosure of Raith fails to cure the deficiencies of Suryanarayana. For example, claim 54 recites, in part, “*a recharge option ... configured to initiate both a connection to a communication network and a recharge transaction, in order to add calling units to the stored*

value calling account." As demonstrated above, Suryanarayana fails to disclose such a recharge option. Similarly, since the entire disclosure of Raith is limited to the communication of cumulative usage information to a user of a wireless communication device (6:5-10), being entirely unconcerned with presenting the user with options to recharge a stored-value account associated with the device (such as, for example, a recharge option as recited in claim 54), Raith cannot cure the failure of Suryanarayana to teach, disclose or suggest at least this limitation. As such, no combination of the Suryanarayana and Raith references can suffice to render obvious claim 54. Thus, for at least the aforementioned reasons, applicants respectfully request withdrawal of the rejection.

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowance covering the pending claims. Please charge any additional fees required, or credit any overpayments, to our Deposit Account No. 11-1540. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

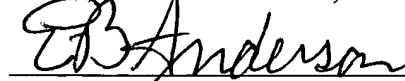
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 22, 2005.


Stephen R. Pendleton

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Edward B. Anderson

Registration No. 30,154

Customer No. 23581

Attorney for Applicants/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679